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09/688,134	10/16/2000	Kanji Nakanishi	Q60940	9987

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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/688,134
Filing Date: October 16, 2000
Appellant(s): NAKANISHI, KANJI

Melvin H. Pollack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 February 2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-18 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,987,230	SHIMIZU, Haruo	11-1999
6,321,266	YOKOMIZO et al.	11-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-18 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 23 June 2004.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu (5,987,230) in view of Yokomizo et al. (6,321,266).

For claim 1, Shimizu teaches a network data terminal (abstract) for printing information obtained from a network (col. 1, line 1 – col. 4, line 10) comprising:

- a printer that is connectable to or incorporated into the data terminal, and is capable of pringing on opposite sides of a recording sheet (col. 1, lines 62-63; "two-sided printing control");
- a memory device for storing ad data received from the network (col. 3, lines 32-33; storing output data based on the intermediate data generated by the generation means);
- a device for allowing a user of the data terminal to choose whether to print the ad data on the dame side of a recording sheet as the information or on the opposite side from the information (col. 1, lines 62-63; corresponds to two-side printing control);
- a print control device that produces print image data for one side or for both sides from the information and the ad data in accordance with which side of the recording sheet the ad data is to print, and controls the printer in accordance with the print image data (consequently the user can utilize the information processing apparatus with default setting matching the loaded memory size, and can also control the memory size for printing by the setting from the operation panel or by the job controlling language, col. 16, lines 64-67).

Shimzu does not expressly disclose a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information. Yokomizo teaches a Centronics I/F controller (abstract; col. 1, line 1 – col. 5, line 5) which performs an I/F control for connecting a printer with a modified Centronics type I/F (col. 17, lines 19-20). At the time the invention was made, one of ordinary skill in the art would have incorporated Yokomizo to Shimizu in order to improve the efficiency of utilization of the memory and to realize optimum memory configurations (col. 1, line 1 – col. 5, line 5).

For claim 2, Shimizu teaches a network data terminal comprising:

- a device for allowing the user to designate categories of the ad data to print with the information (the designation of the memory configuration can be selected according to the environment of utilization by the user; col. 18, lines 6-11);
- a sorting device for sorting out those ad data relating to the designated categories, for use in producing the print image data (the mask objects are sorted and formed into a link list as shown; Fig. 19; col. 13, lines 46-47).

For claim 3, Shimizu teaches a network data terminal, further comprising a device for allowing the user to select the amount of ad data to print with the information, wherein the charge is modified in accordance with the selected printing amount of ad data.
Shimizu does not expressly disclose a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data

printed with the information. Yokomizo teaches a Centronics I/F controller which performs an I/F control for connecting a printer with a modified Centronics type I/F (col. 17, lines 19-20). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate Yokomizo to Shimizu to improve the efficiency of memory utilization and to realize optimum memory configurations.

For claim 4, Shimizu teaches a network data terminal (abstract) for printing information obtained from a network (col. 1, line 1 – col. 4, line 10) comprising:

- a printer that is connectable to or incorporated into the data terminal, and is capable of pringing on opposite sides of a recording sheet (col. 1, lines 62-63; "two-sided printing control");
- a memory device for storing ad data received from the network (col. 3, lines 32-33; storing output data based on the intermediate data generated by the generation means);
- a sorting device for detecting a category of the information to print, and automatically sorting out those ad data relating to the category of the information (Fig. 19; col. 13, lines 46-47; "the mask objects are sorted and formed into a link list);
- a print control device that produces print image data from the information and the ad data sorted by the sorting device, and controls the printer in accordance with the print image data (Fig. 19; col. 13, lines 46-47; "the mask objects are sorted and formed into a link list).

Shimzu does not expressly disclose a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information. Yokomizo teaches a Centronics I/F controller (abstract; col. 1, line 1 – col. 5, line 5) which performs an I/F control for connecting a printer with a modified Centronics type I/F (col. 17, lines 19-20). At the time the invention was made, one of ordinary skill in the art would have incorporated Yokomizo to Shimizu in order to improve the efficiency of utilization of the memory and to realize optimum memory configurations (col. 1, line 1 – col. 5, line 5).

For claim 5, Shimizu teaches a network data terminal further comprising a device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information, wherein the print control device produces print image data for one side or for both sides in accordance with which side of the recording sheet the ad data is to print (col. 1, lines 62-63; two-sided printing control).

For claim 6, Shimizu teaches a network data terminal, further comprising a device for allowing the user to select the amount of ad data to print with the information, wherein the charge is modified in accordance with the selected printing amount of ad data.
Shimizu does not expressly disclose a charge modification data sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information. Yokomizo teaches a Centronics I/F controller which performs an I/F control for connecting a printer with a modified Centronics type I/F (col. 17, lines 19-20). At

the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate Yokomizo to Shimizu to improve the efficiency of memory utilization and to realize optimum memory configurations.

For claim 7, Shimizu teaches a printing method for printing information obtained from a network by use of a printer that is connectable to or incorporated into a data terminal of the network, the method comprising the steps of:

- storing ad data received from the network (col. 3, lines 32-33; storing output data of all types based on the intermediate data generated by the generation means);
- detecting a category of the information to print;
- sorting out those ad data relating to the category of the information (Fig. 19; col. 13, lines 46-47; mask objects are sorted and formed into a link list);
- printing the sorted ad data along with the information (col. 7, line 25; printing job).

Shimizu does not explicitly disclose a modifying charge for provision of the information in accordance with the amount of ad data printed with the information. Yokomizo teaches a Centronics I/F controller which performs an I/F control for connecting a printer with a modified Centronics type I/F (col. 17, lines 19-20). At the time the invention was made, one of ordinary skill in the art would have incorporated Yokomizo to Shimizu to improve the efficiency of memory utilization and to realize optimum memory configurations.

For claim 8, Shimizu teaches a printing method, wherein the information obtained from the network is printed on an obverse side of a recording sheet, whereas the ad data is printed on a reverse side of the recording sheet (col. 1, lines 62-63; two-side printing control).

For claim 9, Shimizu teaches a printing method, further comprising the step of designating the amount of ad data to print with the information (Fig. 19; col. 13, lines 46-47; mask objects are sorted and formed into a link list as shown).

For claim 10, Shimizu teaches a printing method for printing information obtained from a network by use of a printer that is connectable to or incorporated into a data terminal of the network, the method comprising the steps of:

- storing ad data received from the network (col. 3, lines 32-33; storing output data of all types based on the intermediate data generated by the generation means); and
- printing the information on an obverse side of a recording sheet, while printing the ad data on a reverse side of the recording sheet (col. 1, lines 62-63; two-sided printing control).

Shimizu does not explicitly disclose a modifying charge for provision of the information in accordance with the amount of ad data printed with the information. Yokomizo teaches a Centronics I/F controller which performs an I/F control for connecting a printer with a modified Centronics type I/F (col. 17, lines 19-20). At the time the invention was made, one of ordinary skill in the art would have incorporated Yokomizo to Shimizu to improve the efficiency of memory utilization and to realize optimum memory configurations.

For claim 11, Shimizu teaches a printing method, further comprising the step of designating categories of the ad data to print with the information (col. 18, lines 6-11; the designation of the memory configuration can be selected according to the environment of utilization by the user).

For claim 12, Shimizu teaches a printing method further comprising the step of designating the amount of ad data to print with the information (col. 18, lines 6-11; the designation of the memory configuration can be selected according to the environment of utilization by the user).

For claims 13 and 14, Yokomizo discloses a network data terminal, wherein the charge comprises a cost to be paid by the user (col. 82, lines 63-65; the network structure including server devices can be simplified while the memory resources distributed on the network can be effectively put in service at low cost).

For claims 15 and 16, Yokomizo discloses a printing method, wherein the charge comprises a cost to be paid by the user (col. 63, lines 52-55; wherein a printer can be selected corresponding to the purpose of printing. This feature leads to functioning a suitable printer as a network printer corresponding to color printing classification, printer process rate, and printing cost).

For claims 17 and 18, Shimizu discloses a network data terminal wherein the terminal operably receives the combination of video and audio information as a television signal (col. 16, lines 25-26; entered video signal).

(11) Response to Argument

Shimizu is drawn to a method and system (abstract) of modifying the memory within a printer, said printer capable of printing web information through 1-sided or 2-sided copies (col. 1, line 1 – col. 4, line 10) such that memory usage may be better controlled for more efficiency. Because the invention builds upon the printers drawn in the background, rather than moving in a direction different from prior printer evolution, the background information is considered to be part of the invention rather than a separate embodiment.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "selection of which of the two sides is to be printed (P.9, lines 19-20)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). More specifically, the claim language states "a device for allowing a user of the data terminal to choose whether to print the ad data on the same side of a recording sheet as the information or on the opposite side from the information," and states nothing regarding "a manner by which a user can choose a side of a recording sheet to print ad data with respect to the information obtained from a network" nor does it state that the ad data and information has to be printed on the same sheet of paper. The examiner interprets ad and information to be fulfilled by two disparate generic pieces of information, i.e. information which may be printed separately. If a user selects a one-sided copy, then the ad and information would appear on separate sheets of

paper, but upon the same side. If a user selects a two-sided copy, then the ad and information would appear on the same sheet, said ad on side 1 and said information on side 2. Therefore, the steps of single/double printing and sheet selection (Fig. 7, #302-305) teach the limitations of this claim portion as currently drawn.

Applicant then alleges that Shimizu does not expressly disclose "a print control device that produces print image data... in accordance with which side of the recording sheet the ad data is to print..." More specifically, the applicant claims that the raster memory is not a print control device that produces print image data in accordance with two-sided copying. As shown by Shimizu (Fig. 1), The printer is composed primarily of an engine (Fig. 1, #13) and a controller (Fig. 1, #14) in which data is sent to the controller (col. 5, lines 5-10), rendered, and then sent to the printer engine (col. 6, lines 25-50). The components that specifically produce print image data are the hard renderer (Fig. 1, #9) and the bandmaster memory (Fig. 1, #10), said band master memory storing output data and handling memory and speed management (col. 5, line 45 – col. 6, line 25), said memory further changing in cases such as two-sided printing (col. 12, lines 50-55). The decision between 1-sided and 2-sided copying, shown above to fulfill "which side of the recording sheet the ad data is to print," is shown in the aforementioned areas to require not only the obvious changes in print image data production, but also changes to production involving memory management and the like. Hence, this component fulfills the limitations as currently drawn.

Applicant alleges that Yokomizo does not expressly disclose "a charge modification sending device for sending data for modifying charge for provision of the information in accordance with amount of ad data printed with the information." Applicant does not challenge

the reasons for motivation. Yokomizo teaches a method (abstract) of printer controlling (col. 1, line 1 – col. 5, line 5). The Ethernet controller is used in part to transmit printer data (col. 16, lines 40-45) to a particular printer, the printer chosen in part on the suitability (col. 63, lines 49-55). In other words, a change in print image complexity, i.e. double sided images, will cause a more expensive printer to be used, and hence the cost for printing will be modified. Hence, this component fulfills the limitations as currently drawn.

Finally, applicant alleges that Shimizu does not expressly disclose a sorting device, drawn in claim 4, for detecting a category of the information to print, and automatically sorting out those ad data relating to the category of the information. Shimizu teaches (Figs. 15-20) the separation of image data through the masking processes mentioned prior. This is more clearly shown through the extraction and separate storage of certain information (col. 15, lines 10-20), and furthermore controlled by options chosen, via memory size, for different rendering options for the same image data (col. 9, lines 60-67). Hence, the image data is broken up and categorized in order to aid in rendering control, as does other categorization techniques such as page separation. Hence, these limitations are also fulfilled.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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SUPERVISORY PATENT EXAMINER

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June 17, 2005

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